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SCHIEF HARDIN, LLP PATENT DEPARTMENT 6600 SEARS TOWER CHICAGO, IL 60606-6473				
EXAMINER				
POPOVICI, DOV				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/509,805

Applicant(s)

SCHWIER ET AL.

Examiner

Dov Popovici

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2005.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 11-21 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 11-21 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 30 September 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-85/86)  
Paper No(s)/Mail Date 09/30/2004  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION*****Drawings***

The drawings (filed on 09/30/2004) are objected to because the unlabeled rectangular boxes shown in the drawings (Figure 3, filed on 09/30/2004) should be provided with descriptive text labels and in figure 4, filed on 09/30/2004, the German language text description should be translated into the English language. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

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In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as "Annotated Sheets" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d)(1). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

The drawings were received on 05/04/2005 and 10/14/2005. These drawings are not acceptable.

In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as "Annotated Sheets" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d)(1). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

Furthermore, figure 4 filed on 5/4/2005, has not been identified as required in the Notice of Non-Compliant Amendment (37 CFR 1.121) dated 09/29/2005.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 20 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 20 is claiming a program per se. Claim 20 is directed to non-statutory functional descriptive material. "Computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035. " " Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and USPTO personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, as nonstatutory functional descriptive material" (see Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 17, lines 1-2, the claimed recitation of "wherein the file is printed to the file" is unclear, vague and indefinite in the context of the claim. It is unclear as to what "wherein the file is printed to the file" is referring to?

Clarification is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11-12, 14-16 and 19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Parsons et al. (EP 0 479 494 A2).

As to claim 11, Parsons et al. discloses a method for printing a file on sheets with register pages (210) inserted between them, the file containing

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register page file parameters (electronic images) describing the register pages, comprising the steps of: storing register page print parameters that describe a stack of register pages existing in an input tray (Paper Supply 107) in a control device (7) of a printer (see figures 1A and 2-3); in the event that, upon printing of the file, it is established using the register page file parameters that a register page is to be processed, comparing the register page file parameters describing the register page to be printed with the register page print parameters in order to establish whether the next register page to be drawn from the input tray coincides with the register page to be processed (see abstract, where it is stated that "determining the number of different sheets 210 of stock per group from the number of said electronic pages in said job and the number of prints to be made"), see figure 18, determine the number of prints per group, and see column 2, lines 5-7 and see column 1, line 51 to column 2, line 20, column 9, line 32 to column 10, line 23 and see figures 2-3 and 16-18); and in the event that this is not the case, drawing register pages from the input tray and supplying them to an output tray until a register page coinciding with the register page to be printed is drawn from the input tray and then processing and supplying that register page to the output tray (see abstract, column 1, line 51 to column 2, line 20, column 9, line 32 to column 10, line 23 and see figures 2-3 and 16-18).

As to claim 12, Parsons et al. discloses wherein register pages not to be processed are supplied to a separate output tray not provided for the register pages to be processed (see column 2, lines 8-20 and see column 9, line 32 to col. 10, line 23).

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As to claim 14, Parsons et al. discloses wherein the register pages drawn from the input tray are counted by a counting device (purge counter 260 and print-set counter 262) and the register page print parameters are corrected using a determined counting value (see col. 9, line 32 to col. 10, line 23).

As to claim 15, Parsons et al. discloses wherein sheets printed in a printing unit of the printer (120) are counted by a counting device (print-set counter 262) and the register page file parameters are adjusted using the determined counting value (see column 9, line 32 to col. 10, line 23).

As to claim 16, Parsons et al. discloses wherein the file to be printed exists in at least one of the print formats Postscript, PCL, PPML, AFPDS, IPDS and PDF (see column 3, lines 39-49, where PDL reads on: PostScript – a PDL from Adobe Systems).

As to claim 19, Parsons et al. discloses a printing device (see figures 2-3) for printing a file on sheets with registered pages (210) inserted between them, the file containing register page file parameters (electronic images) describing the register pages, comprising: a controller (see figure 2, controller 7) in which the file to be printed is converted into a control signal to control a printing unit (8); a control device (54), an input tray (110, 112, 114), a paper transport device (see figure 3), a printing unit (120), an output tray (118, 122), and a software module (see figures 5A, 5B, 5C, 6-10 and 14-15) stored in the control device (54); the control device (54) having stored therein register page print parameters that



describe a stack of register pages existing in the input tray (paper supply 107); and the software module, in the event that upon printing of the file it is established using the register page file parameters that a register page is to be processed, the register page file parameters describing the register page to be printed are compared with the register print parameters (see abstract, where it is stated that "determining the number of different sheets 210 of stock per group from the number of said electronic pages in said job and the number of prints to be made"), see figure 18, determine the number of prints per group, and see column 2, lines 5-7 and see column 1, line 51 to column 2, line 20, column 9, line 32 to column 10, line 23 and see figures 2-3 and 16-18) in order to establish whether the next register page to be drawn from the input tray coincides with the register page to be processed, and in the event that this is not the case, drawing register pages from the input tray and supplying them to the output tray until a register page coinciding with the register page to be printed is drawn from the input tray, and then processing and supplying that register page to the output tray (see abstract, column 1, line 51 to column 2, line 20, column 9, line 32 to column 10, line 23 and see figures 2-3 and 16-18).

As to claim 20, Parsons et al. discloses a computer program for operation on a control device (7) of a printer (8) for controlling a printing of a file on sheets with register pages inserted between them, the file containing register page file parameters describing the register pages, said program storing register page print parameters that describe a stack of register pages existing in an input tray, and in the event that upon printing of the file, it is established using the

register page file parameters that a register page is to be processed, the register page file parameters describing the registered page to be printed are compared with the register page print parameters (see abstract, where it is stated that "determining the number of different sheets 210 of stock per group from the number of said electronic pages in said job and the number of prints to be made"), see figure 18, determine the number of prints per group, and see column 2, lines 5-7 and see column 1, line 51 to column 2, line 20, column 9, line 32 to column 10, line 23 and see figures 2-3 and 16-18) in order to establish whether the next register page to be drawn from the input tray coincides with the register page to be processed, and in the event that this is not the case, drawing register pages from the input tray and supplying them to an output tray until a register page coinciding with the register page to be printed is drawn from the input tray, and then processing and supplying that register page to the output tray (see abstract, column 1, line 51 to column 2, line 20, column 9, line 32 to column 10, line 23 and see figures 2-3 and 16-18).

As to claim 21, Parsons et al. discloses a method for printing a file on sheets with register pages inserted between them, the file containing register page file parameters describing the register pages, comprising the steps of: storing register page print parameters that describe a stack of register pages at an input; in the event that, upon printing of the file, it is established using the register page file parameters that a register page is to be processed, comparing the register page file parameters describing the register page to be printed with the register page print parameters (see abstract, where it is stated that

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"determining the number of different sheets 210 of stock per group from the number of said electronic pages in said job and the number of prints to be made"), see figure 18, determine the number of prints per group, and see column 2, lines 5-7 and see column 1, line 51 to column 2, line 20, column 9, line 32 to column 10, line 23 and see figures 2-3 and 16-18) in order to establish whether the next register page to be drawn from the input stack coincides with the register page to be processed; and in the event that this is not the case, drawing one or more register pages from the input tray and supplying one or more of them to an output stack until a register page coinciding with the register page to be printed is drawn from the input stack and then processing and supplying that register page to the output (see abstract, column 1, line 51 to column 2, line 20, column 9, line 32 to column 10, line 23 and see figures 2-3 and 16-18).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Parsons et al. (EP 0 479 494 A2).

As to claim 13, Parsons et al. does not specifically specify wherein register pages not to be processed are printed with an error marking.

However, the examiner is taking "Official Notice" that printing, marking or labeling a page or plural pages not to be processed or purged by the system with an error marking is well known in the art.

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Parsons et al: wherein register pages not to be processed are printed with an error marking.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Parsons et al: wherein register pages not to be processed are printed with an error marking because of any one of the following reason(s): (1) so that the user will know that these register pages with the error markings have not been processed and have been purged from the system as unused tabbed sheets; (2) so that tabbed pages purged from the system can be easily identified by the user as pages with error marking as purged from the system, thereby, preventing the user from mixing up in the final output the purged register pages with the printed sheets.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parsons et al. (EP 0 479 494 A2) in view of Kelley et al. (U.S. 5,210,622).

As to claim 17, Parsons et al. discloses tabbed sheets (210) having tabs (212) wherein the tabs (212) may be clear or have data preprinted thereon (see col. 8, lines 30-40).

Parsons et al. does not specifically specify wherein the file is printed to the file comprising at least two logical sides, one of the two sides being associated with the flag of a register page and the other logical side being associated with a remaining region of the same register page.

Kelley et al. discloses automatic variable image shift for precut tabs, wherein the file is printed to the file comprising at least two logical sides (see figures 9 and 10), one of the two sides being associated with the flag (i.e., "INDEX" or "F-J", see figures 9 and 10) of a register page and the other logical side being associated with a remaining region of the same register page.

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Parsons et al: wherein the file is printed to the file comprising at least two logical sides, one of the two sides being associated with the flag of a register page and the other logical side being associated with a remaining region of the same register page.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Parsons et al. by the teaching of Kelley et al. wherein the file is printed to the file comprising at least two logical sides, one of the two sides being associated with the flag of a register page and the other logical side being associated with a remaining region of the same register page, because of any one of the following reason(s): (1) so that certain images can be variably shifted on the output sheets, and the variable image shift is particularly useful for printing on tabs where the original documents are all of a standard size, and the images are specially shifted onto the tabs during printing, as taught by Kelley et al. at the abstract and at col. 1, line 54 to col. 2, line 61); (2) so that the file information or output print data can be directly printed on the tabbed portion(s) of the tabbed sheet(s) as opposed to having the tabbed portion(s) left blank or clear or having data pre-printed thereon, thus, making the print system more efficient, by reducing the need to have data pre-printed on the tabbed portion(s), and providing the user with the ability to print information directly on the tabbed portion(s), so that the tabbed sheet(s) can be easily identified with the printed tabbed portion(s) in the tabbed sheet(s).

As to claim 18, Parsons et al. does not specifically specify wherein the file is printed on a register page, the file comprising register page file parameters that define a shape of the register page to be printed and thus establish the region to be printed.

Kelley et al. teaches automatic variable image shift for precut tabs, wherein the file is printed on a register page, the file comprising register page file parameters that define a shape of the register page to be printed and thus establish the region to be printed.

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Parsons et al: wherein the file is printed on a register page, the file comprising register page file parameters that define a shape of the register page to be printed and thus establish the region to be printed.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Parsons et al. by the teaching of Kelley et al. wherein the file is printed on a register page, the file comprising register page file parameters that define a shape of the register page to be printed and thus establish the region to be printed, because of any one of the following reason(s): (1) so that certain images can be variably shifted on the output sheets, and the variable image shift is particularly useful for printing on tabs where the original documents are all of a standard size, and the images are specially shifted onto the tabs during printing, as taught by Kelley et al. at the abstract and at col. 1, line 54 to col. 2, line 61); (2) so that the file information or output print data can be directly printed on the tabbed portion(s) of the tabbed sheet(s) as opposed to having the tabbed portion(s) left blank or clear or having data pre-printed thereon, thus, making the print system more efficient, by

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reducing the need to have data pre-printed on the tabbed portion(s), and providing the user with the ability to print information directly on the tabbed portion(s), so that the tabbed sheet(s) can be easily identified with the printed tabbed portion(s) in the tabbed sheet(s); and (3) so that data can be directly printed on the register sheet(s) or page(s) and wherein the data printed directly on the register page(s) can be printed at the user desired location and/or region to be printed and with defining the shape of the register pages to be printed.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dov Popovici whose telephone number is 571-272-4083. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dov Popovici/  
Primary Examiner, Art Unit 2625